

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/688,708
Patent No. : 7,084,010
Title : Integrated Package Design and Method for a Radiation Sensing Device
Inventors : Adam M. KENNEDY, et al.
Issued : August 1, 2006
Filed : October 17, 2003
Atty Docket No. : 831-0002
Customer No. : 29855

Mail Stop PETITION
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF DISMISSAL OF PETITION

Patent Owner, Raytheon, Inc. ("Raytheon") hereby submits this petition for reconsideration of the decision of September 10, 2009 (the "Decision") to dismiss Raytheon's petition, filed June 22, 2009, to retroactively revive the subject application pursuant to 37 C.F.R. § 1.137(f). The Decision stated that the Office has no jurisdiction over the patent once it issues, citing MPEP 1305 and *Aristocrat Tech. Australia v. Int'l Game Tech.*, 543 F.3d 657 (Fed. Cir. 2008).

The MPEP, PTO rules, and patent statute provide only one avenue for correcting an unintentional abandonment caused by failure to notify the office of foreign filings subsequent to the filing of a non-publication request. That remedy is a petition to revive under 37 C.F.R. § 1.137(f). Therefore, Raytheon requests reconsideration of the determination that the Office lacks jurisdiction to retroactively grant the petition for revival of the unintentionally abandoned application.

The provisions of MPEP 1305 do not apply because this section relates only to substantive, not procedural, issues and because the relief requested is retroactive to before the patent issued. The *Aristocrat* case is not applicable because the present petition relates to abandonment by operation of the statute (35 U.S.C. § 122(b)(2)(B)(iii)) and not merely due to a

technical violation of PTO rules. Finally, MPEP 1124 provides that Raytheon's exclusive remedy is a retroactive petition for revival. The provisions of 37 C.F.R. § 1.137 expressly contemplate application of that section to issued patents.

I. MPEP 1305 IS INAPPLICABLE TO THE INSTANT PETITION

In dismissing Raytheon's Petition, the Office relies in part on MPEP 1305, which provides that:

Once the patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

Raytheon respectfully submits that the cited provision, which is found in the MPEP chapter entitled "Allowance and Issue," relates only to the Office's substantive jurisdiction, and not to ministerial or procedural issues. For example, the first two paragraphs of MPEP 1305 (which immediately precede the cited paragraph) describe the Examiner's limited jurisdiction to make amendments to the case after a Notice of Allowance and how the Examiner may regain jurisdiction from the Director.

The Office routinely exercises procedural jurisdiction over issued patents in many circumstances, such as the payment of maintenance fees (37 C.F.R. § 1.362–63), petitions concerning the refusal to accept payment of a maintenance fee (37 C.F.R. § 1.377), petitions to reinstate patents that expired for failure to pay maintenance fees (37 C.F.R. § 1.378), improper payment of small entity fees (37 C.F.R. § 1.28(c); MPEP 509.03), or retroactive grants of foreign filing licenses (37 C.F.R. § 5.25; MPEP 140). Raytheon respectfully submits that none of these examples of the Office exercising jurisdiction are related to the statutory sections referenced in MPEP 1305. It is further suggested that the instant petition is analogous to a petition under § 1.377 or § 1.378, which by their very terms can relate only to an issued patent. Therefore, the instant petition is within the jurisdiction of the Office.

Moreover, as set forth in greater detail below the present petition was filed under 37 C.F.R. § 1.137, "Revival of abandoned applications ... or lapsed patents," which by its own terms and even its own title refers to the revival of lapsed patents. Thus, the Office must have jurisdiction to consider such petitions in the case of issued patents.

Raytheon further respectfully notes that the instant petition is for *retroactive* revival of the application that ultimately issued. This retroactivity further renders MPEP 1305 inapplicable because the relief sought would retroactively “undo” the unintentional abandonment that occurred prior to allowance and issue of the patent.

II. *ARISTOCRAT* IS INAPPLICABLE RAYTHEON’S PETITION

In dismissing Raytheon’s petition, the Office further relies on *Aristocrat* for the proposition that “procedural lapses during examination, should they occur, do not provide grounds of invalidity” *Aristocrat*, 543 F.3d at 663 (internal quotations and citations omitted). However, the “procedural lapse” in question related merely to a purported violation of the Office’s rules. In contrast, the present petition relates to a statutorily-mandated abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii). In *Aristocrat* the Federal Circuit recognized that such a distinction between mere procedural violations and statutory requirements was critical. *Aristocrat*, 543 F.3d at 664. Moreover, the Federal Circuit noted that “failure to impose invalidity for violation of the statute would encourage non-compliance.” *Id.* Thus, in this case, *Aristocrat* does not support the Office’s dismissal of Raytheon’s petition. Moreover, because the MPEP, the Rules, and the statute all contemplate a petition for revival of applications unintentionally abandoned for failure to notify the office of foreign filings after the filing of a non-publication request, the Office is empowered to consider Raytheon’s petition, and, on the facts presented, obligated to grant such a petition.

III. *MPEP* 1124 PROVIDES THAT A PETITION TO REVIVE IS A PATENTEE’S EXCLUSIVE REMEDY TO CORRECT AND UNINTENTIONAL ABANDONMENT RELATED TO FAILURE TO NOTIFY OF FOREIGN FILINGS

Raytheon further requests reconsideration of the dismissal of its petition because the Office’s dismissal of the petition without determination leaves Raytheon without a remedy to correct the unintentional abandonment of the application. MPEP 1124 provides that “applicant’s sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application on the basis of unintentional delay....” This same section further provides that:

if applicant failed to file a notice of foreign filing when it was required, prosecution of the application will continue and the application may issue as a patent, even though the application has become abandoned by operation of the statute. Applicants who determine that a required notice of foreign filing was not timely provided should promptly file a petition to revive under 37 CFR 1.137(b).

Thus, not only does the MPEP provide that a petition to revive is the only way to correct an unintentional abandonment, but the MPEP also specifically contemplates the present situation in which the unintentional abandonment was not noticed by either Applicant or the Office and a patent issued on the unintentionally abandoned application. After making this observation, the MPEP, in the very next sentence, again explains that a petition to revive the unintentionally abandoned application should be promptly filed. The clear implication is that the petition should be promptly filed even if discovered after the patent issues. Moreover, as noted above, the provisions of 37 C.F.R. § 1.137(b), and even its very title, suggest applicability of the section to patents as well as applications.

It is a well-settled principle of statutory construction that specific language trumps conflicting general language. Thus, the general statement of MPEP 1305—that the Office lacks jurisdiction over issued patents except in interferences (§ 135); reissues, disclaimers, certificates of correction, and correction of inventorship (§§ 251–56); *ex parte* re-examination (§§ 302–07); and *inter partes* re-examination (§§ 311–16)—is trumped by the specific language of MPEP 1124 and 37 C.F.R. § 1.137(b), which provides that a petition to revive an unintentionally abandoned application is the exclusive remedy when an application has become unintentionally abandoned for failure to notify the Office of a foreign filing.

IV. FEES

Please charge the amount of any fees or credit any overpayment due in connection with this Request or the underlying petition to Wong, Cabello, Lutsch, Rutherford & Brucculeri, LLP Deposit Account Number 501922, referencing attorney docket number 831-0002.

V. CONCLUSION

For the foregoing reasons, Raytheon respectfully requests that the Office reconsider the petition filed June 22, 2009 and retroactively revive the 10/688,708 application, which became

unintentionally abandoned for failure to timely notify the Office of foreign filings after the filing of a non-publication request.

Date: October 13, 2009

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